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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/505,285	10/27/2004	Lionel Breton	112701-432	6015

7590  
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01/04/2008

EXAMINER
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BARNHART, LORA ELIZABETH

ART UNIT	PAPER NUMBER
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1651

MAIL DATE	DELIVERY MODE
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01/04/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/505,285

Applicant(s)

BRETON ET AL.

Examiner

Lora E. Barnhart

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/13/07 has been entered.

### ***Response to Amendments***

Applicant's amendments filed 9/13/07 to claim 9 have been entered. No claims have been cancelled or added in this reply. Only claim 9 remains pending in the current application and is being considered on its merits. Prior art references not included with this Office action can be found in a prior action.

### ***Claim Rejections - 35 USC § 112***

The rejections of record under 35 U.S.C. § 112, second paragraph, are withdrawn in light of the claim amendments.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shields, Jr. et al. (2000, U.S. Patent 6,156,355) taken in view of Spangler et al. (2003, U.S. Patent 6,524,574) and Hanna (1976, U.S. Patent 3,946,123). The claim is drawn to a pet food composition comprising at least  $10^5$  cfu probiotic lactic acid bacterium or culture supernatant thereof and at least  $10^5$  cfu yeast per gram of the composition, said composition further comprising between  $10^{-12}\%$  and 20% of at least one carotenoid.

Shields teaches dog food formulations comprising dried yeast, vitamin A, beta carotene, probiotic bacteria (*Lactobacillus acidophilus* and *Enterococcus faecium*), and fermentation extracts of probiotic bacteria (*Bacillus subtilis*, *Aspergillus oryzae*, and *Aspergillus niger*), as well as numerous sources of protein, fat, and fiber (Examples 5 and 6; note in particular column 21, lines 48-49; 50-51; 54; and 60-63).

Shields, Jr. et al. do not explicitly teach the particular amounts of probiotic bacteria, yeast, or carotenoids in their composition.

Spangler teaches a pet food formulation comprising  $3.3 \times 10^8$  cfu of probiotic lactic acid-producing bacterium (*Enterococcus* or *Lactobacillus*) and the yeast *Saccharomyces cerevisiae* per gram of the food formulation (column 4, lines 50-52, and column 5, lines 20-26 and 34-38)<sup>1</sup>. Spangler teaches that the amounts of the bacteria and yeast relative to each other and to the composition may be varied as required by the person of ordinary skill in the art (column 4, line 66, though column 5, line 28).

Hanna teaches that carotenoids may be added to pet foods to impart desired color thereto and that the amount of carotenoid added is optimizable (column 3, lines 52-63).

The selection of the amount of probiotic bacteria, yeast, and carotenoids to be included in the composition of Shields, Jr. et al. would have been a routine matter of optimization on the part of the artisan of ordinary skill, said artisan recognizing that Spangler and Hanna teach that amounts of these components within a pet food composition may vary depending on the animal's dietary needs and the desired properties of the food composition. Furthermore, Shields, Jr. et al. teach that the nutritional needs of dogs, for example, vary by breed type (column 4, line 63, through column 5, line 33). A holding of obviousness over the cited claims is therefore clearly required, absent a showing of unexpected results. See *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).

Therefore, the invention as a whole would have been *prima facie* obvious to a person of ordinary skill at the time the invention was made.

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<sup>1</sup>  $150 \times 10^9$  cfu per pound is equivalent to  $3.3 \times 10^8$  cfu per gram.

Applicant alleges that the cited prior art is non-analogous because the three references address different aspects of pet nutrition (Reply, page 4, last paragraph, through page 5, first paragraph). Applicant alleges that the cited prior art did not recognize that the instantly claimed composition has a photoprotective effect (Reply, page 5, second paragraph). Applicant alleges that combining the references as discussed in the rejection would render the prior art composition unsatisfactory for its intended purpose (Reply, page 5, third paragraph, through page 6, first paragraph). These arguments have been fully considered, but they are not persuasive.

In response to applicant's argument that Spangler and Hanna are nonanalogous to the primary Shields reference, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, all three references are within the domestic pet nutrition art. Shields teaches pet food formulations that comprise probiotic bacteria and thereby promote general pet health. Spangler was relied upon solely for the suggestion of including baker's yeast in a pet food composition that also comprises probiotic bacteria; Hanna was relied upon solely for the suggestion of including carotenoids in a pet food composition in order to alter the color. All three references need not address exactly the same problem to be considered analogous. All that is required is that the references be "in the field of applicant's endeavor," i.e. pet food formulations.

In response to applicant's argument that the cited prior art did not recognize that a composition comprising probiotic bacteria, yeast, and carotenoids would have a photoprotective effect, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). As has been discussed at length in previous Office actions, the claims are drawn to a composition, not to any manner of using said composition. The claimed composition contains three components that, as evidenced by the cited prior art, were well known ingredients in pet food formulations at the time of the invention.

Applicant's allegation that adding the yeast of Spangler and the carotenoid of Hanna to the pet food formulation of Shields would render the composition of Shields unsatisfactory for its intended purpose is not substantiated by evidence. As discussed above, the composition of Shields is a health-promoting pet food that comprises probiotic bacteria. Spangler and Hanna each teach components that are well-known ingredients of pet food. Applicant has provided no evidence and insufficient reason that the person of ordinary skill in the art would have reasonably expected that adding the yeast and carotenoid components of Spangler and Hanna, respectively, would have rendered the pet food of Shields unsatisfactory for its intended purpose, i.e. complete, health-promoting nutrition.

***No claims are allowed. No claims are free of the art.***

Applicant is requested to specifically point out the support for any amendments made to the disclosure in response to this Office action, including the claims (MPEP 714.02 and 2163.06). In doing so, applicant is requested to refer to pages and line numbers in the as-filed specification, **not** the published application. Due to the procedure outlined in MPEP § 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 U.S.C. § 102 or 35 U.S.C. § 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is requested to provide a list of all copending U.S. applications that set forth similar subject matter to the present claims. A copy of such copending claims is requested in response to this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lora E. Barnhart whose telephone number is 571-272-1928. The examiner can normally be reached on Monday-Thursday, 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lora E Barnhart  
Examiner/Partial Signatory Authority  
Temporary Full Signatory Authority (as of 12/9/07)

